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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/611,804	03/06/96	WOHLSTADTER	J 370068-6150
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021675 HM12/0622  
BARRY EVANS  
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EXAMINER

CHIN, C

ART UNIT	PAPER NUMBER
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1641

16

DATE MAILED:

06/22/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

05/611,804

Applicant(s)

Wohlstaetter et al

Examiner

C. Chin

Group Art Unit

1641

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on 3/4/99 & 3/29/99
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1, 2, 5-9, 11, 17-25, 27-30, 32, 35-37, 46, 47, 61-63, 70, 80-158 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1, 2, 5-9, 11, 17-25, 27-30, 32, 35-37, 46, 47, 61-63, 70, 80-158 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

Office Action Summary

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## DETAILED ACTION

### *Double Patenting*

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1, 2, 5-9, 11, 17-25, 27-30, 32, 35-37, 46, 47, 61-63, 78, and 80-158 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 40-104 of copending Application No. 08/470,089. Although the conflicting claims are not identical, they are not patentably distinct from each other for the reasons of record in paper 11.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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3. Claims 1, 2, 5-9, 11, 17-25, 27-30, 32, 35-37, 46, 47, 61-63, 78, and 80-158 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 40-153 of copending Application No. 08/470,874. Although the conflicting claims are not identical, they are not patentably distinct from each other for the reasons of record in paper 11.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

4. Claims 1, 2, 5-9, 11, 17-25, 27-30, 32, 35-37, 46, 47, 61-63, 78, and 80-158 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 80 of copending Application No. 08/471,050. Although the conflicting claims are not identical, they are not patentably distinct from each other for the reasons of record in paper 11.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

5. Claims 1, 2, 5-9, 11, 17-25, 27-30, 32, 35-37, 46, 47, 61-63, 78, and 80-158 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 32, 34, and 40-98 of copending Application No. 08/402,277. Although the conflicting claims are not identical, they are not patentably distinct from each other

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because copending '277 claims essentially the same invention(s) as recited in the instant application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

6. Claims 1, 2, 5-9, 11, 17-25, 27-30, 32, 35-37, 46, 47, 61-63, 78, and 80-158 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9, 11-36, and 39-51 of copending Application No. 08/479,425. Although the conflicting claims are not identical, they are not patentably distinct from each other because copending '425 claims essentially the same invention(s) as recited in the instant application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

7. Claims 1, 2, 5-9, 11, 17-25, 27-30, 32, 35-37, 46, 47, 61-63, 78, and 80-158 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 37, and 40-112 of copending Application No. 08/472,021. Although the conflicting claims are not identical, they are not patentably distinct from each other because copending '021 claims essentially the same invention(s) as recited in the instant application.

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This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

8. Claims 1, 2, 5-9, 11, 17-25, 27-30, 32, 35-37, 46, 47, 61-63, 78, and 80-158 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 70 and 71 of copending Application No. 08/402,076. Although the conflicting claims are not identical, they are not patentably distinct from each other because copending '076 claims essentially the same invention(s) as recited in the instant application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

9. Claims 61-63 and 151-158 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2-6 and 15-18 of copending Application No. 08/814,085. Although the conflicting claims are not identical, they are not patentably distinct from each other because copending '085 claims kits having essentially the same limitations as the kits recited in the instant application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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10. Claims 1, 2, 5-9, 11, 17-25, 27-30, 32, 35-37, 46, 47, 61-63, 78, and 80-158 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 4 and 30-83 of copending Application No. 08/814,141. Although the conflicting claims are not identical, they are not patentably distinct from each other because copending '141 claims essentially the same invention(s) as recited in the instant application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

11. Claims 61-63 and 151-158 of this application conflict with claims 2-6 and 15-18 of Application No. 08/814,085. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

12. Claims 1, 2, 5-9, 11, 17-25, 27-30, 32, 35-37, 46, 47, 61-63, 78, and 80-158 of this application conflict with claims 4 and 30-83 of Application No. 08/814,141. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting

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claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

*Conclusion*

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chris Chin whose telephone number is (703) 308-3991. The examiner can normally be reached on Monday-Thursday from 8:30 am to 6:00 pm. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Housel, can be reached on (703) 308-4027. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

cchin/cc  
June 21, 1999

*Christopher L. Chin*  
CHRISTOPHER L. CHIN  
PRIMARY EXAMINER  
GROUP 1800-1641



08/611,804

New Dependent Claim (6150 Apparatus)	Support in specification (page number, reference, figure, section, etc.)
89 ECL moiety	78
90 organometallic	78
91 Ru, Os	78
92, 94, 95 # discrete binding domains	36
93 # discrete binding domains	20
96, 97 binding domain size	20
98, 99 hydrophobic	14
100, 101 covalent	14
102, 103 protein	36-37
104 transparent gold	49
105 patterned SAMs	19
106 patterned SAMs thiol	29, 65
107 A-B	31-32
108-109 hydrophobic/hydrophilic	8
110 internal standard	39
111-113 transparent	73
114 separately addressable electrodes	Section 5.4, 77-78
115 film	46
116 imaging	46
117-122 light detector	46
123 conductive	9-10
124 support comprises...	21
125, 126 electrode carbon nanotubes, carbon black, matrices	21, 49-50
127, 128 electrode carbon nanotubes	49
129, 130 nanotubes in matrix	22
131 support graphite, carbon black	21
132 support nanotubes	21
133 support carbon particles in matrix	22
134, 135 electrode graphite...	21
136, 137 electrode particles in matrix	22
138 functionalized nanotubes	113, Figures 26-28
139 conducting projections	68
140 single fluid chamber	73
141 electrode porous	24
142 flow-through electrode	75, 90
143 electrode porous	24
144 electrode flow through	75, 90

New Dependent Claim (6150 Apparatus)	Support in specification (page number, reference, figure, section, etc.)
145 counter electrode	Ubiquitous
146 different specificity	37-38
147, 148 predetermined amount	14
149 counter fixed	Figure 6B
150 electrode/counter pairs	5
151 single chamber	73
152 single fluid	72-73
153, 154	22, 49
155, 156	9, 22, 49, 19, 29, 65
157-158	78